

ESTTA Tracking number: **ESTTA329884**

Filing date: **02/01/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	3M Company
Granted to Date of previous extension	01/31/2010
Address	2501 Hudson Road St. Paul, MN 55114 UNITED STATES

Attorney information	Susan J. Hightower Pirkey Barber LLP 600 Congress Ave., Suite 2120 Austin, TX 78701 UNITED STATES bbarber@pirkeybarber.com, shightower@pirkeybarber.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512-322-5200
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Applicant Information

Application No	77726137	Publication date	08/04/2009
Opposition Filing Date	02/01/2010	Opposition Period Ends	01/31/2010
Applicant	Xerox Corporation 45 Glover Ave., P.O. Box 4505 Norwalk, CT 068564505 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Identification cards, namely, copy paper with adhesive properties for use in providing personal and business identification information
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1046353	Application Date	12/29/1975
Registration Date	08/17/1976	Foreign Priority Date	NONE
Word Mark	POST-IT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 PAPER AND CARDBOARD SHEET MATERIAL HAVING ADHESIVE COATING ON BOTH SIDES THEREOF FOR ATTACHMENT TO WALLS OR OTHER VERTICAL SURFACES TO HOLD DISPLAYS OR OTHER MESSAGES IN PLACE


U.S. Registration No.	1198694	Application Date	03/12/1981
Registration Date	06/22/1982	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery Notes Containing Adhesive on One Side for Attachment to Surfaces		


U.S. Registration No.	1208297	Application Date	11/19/1981
Registration Date	09/14/1982	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1981/10/01 First Use In Commerce: 1981/10/01 Trays for Holding Stationery Notes		

U.S. Registration No.	1284295	Application Date	06/30/1983
Registration Date	07/03/1984	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1983/01/01 First Use In Commerce: 1983/01/01 Adhesive Tape for Home and Office Use		

U.S. Registration No.	1935381	Application Date	11/14/1994
Registration Date	11/14/1995	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 016. First use: First Use: 1994/05/24 First Use In Commerce: 1994/05/24 adhesive backed easel paper and easel pads
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U.S. Registration No.	2736421	Application Date	09/04/2002
Registration Date	07/15/2003	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; [glue sticks for stationery or office use;] and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place		

U.S. Registration No.	3168105	Application Date	11/11/2005
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads,		

	art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper
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Attachments	76446169#TMSN.gif (1 page)(bytes) 78751997#TMSN.jpeg (1 page)(bytes) 3MTM037 Notice of Opppsition.pdf (6 pages)(895775 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/SJH/
Name	Susan J. Hightower
Date	02/01/2010

In Re Serial No. 77/726,137
 Filed: April 30, 2009
 Mark: **TAC-IT**
 Published: August 4, 2009

Applicant.

Opposition No. _____

Opposer 3M Company, a Delaware corporation located at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55114, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer develops and markets innovative products and solutions that serve a diverse field of customers. Opposer introduced the now-famous POST-IT brand of adhesive-based paper and stationery notes approximately thirty years ago. Since that time, Opposer has used the POST-IT mark extensively in connection with a variety of highly successful consumer and office products. Opposer's POST-IT mark is among the most famous marks in the United States, with very high brand awareness levels.

2. Opposer's POST-IT mark is famous within the meaning of 15 U.S.C. § 1125(c)(2)(A).

See Minnesota Min. & Mfg. Co. v. Taylor, 21 F. Supp. 2d 1003, 1005, 48 USPQ2d 1701, 1702 (D. Minn. 1998) (finding POST-IT mark famous).

3. In addition to its extensive common-law rights, Opposer is the owner of numerous United States Trademark Registrations for its POST-IT mark. Opposer's registrations include, but are not limited to, those shown in the following chart:

Registration Number	Date Issued	Goods (all in Class 16)
1046353	8/17/76	Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place
1198694	6/22/82	Stationery notes containing adhesive on one side for attachment to surfaces
1208297	9/14/82	Trays for holding stationery notes
1284295	7/3/84	Adhesive tape for home and office use
1935381	11/14/95	Adhesive backed easel paper and easel pads
2736421	7/15/03	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place
3168105	11/7/06	Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper

Each of the registrations listed in the preceding chart is valid and subsisting, and all but the last one are incontestable pursuant to 15 U.S.C. § 1065.

4. Applicant Xerox Corporation is a New York corporation with a business address of 45 Glover Ave., P.O. Box 4505, Norwalk, CT 06856-4505.

5. Applicant filed application Serial No. 77/726,137 (“the Application”) on an intent-to-use basis pursuant to 15 U.S.C. § 1051(b) on April 30, 2009 for the mark TAC-IT (“Applicant’s Mark”) for the following Class 16 goods: “Identification cards, namely, copy paper with adhesive properties for use in providing personal and business identification information.”

6. The Application was published in the *Official Gazette* on August 4, 2009. Opposer timely requested and received extensions of time until January 31, 2010 to file a Notice of Opposition. Because that date fell on a Sunday, this Notice of Opposition filed Monday, February 1, 2010 is timely. 37 C.F.R. § 2.196; TBMP 209.02.

7. On information and belief, Applicant has not filed an allegation of use in connection with the Application, and is not yet using Applicant’s Mark in commerce.

8. Opposer has priority based on its prior use and registration of its mark POST-IT in the United States.

9. Opposer’s mark POST-IT became famous long prior to Applicant’s filing date or any priority date that Applicant may claim for Applicant’s Mark.

10. Applicant’s Mark is confusingly similar to Opposer’s mark POST-IT. Applicant’s Mark TAC-IT is very similar to the mark POST-IT in sight, sound, meaning, and overall commercial impression. In particular, “tac” is simply a phonetically identical misspelling of “tack,” as reflected in the pseudo mark TACK-IT assigned to the Application. The verbs “tack” (attach)

and “post” (affix to a usual place) can be used synonymously. Furthermore, Opposer’s products sold under the POST-IT mark are well-known for their unique adhesive properties; Applicant’s goods covered by the Application likewise use adhesive. The noun “tack” (along with its adjective form “tacky”) is commonly used to mean “a sticky or adhesive quality or condition.” The term TAC, particularly combined with the identical suffix -IT, is highly likely to be associated by consumers with Opposer’s well-known POST-IT adhesive products. Thus, both marks comprise one-syllable synonyms and/or related terms followed by -IT.

11. The goods in the Application are directly competitive with, or similar or related to, the goods for which Opposer uses and has registered its mark POST-IT.

12. Because the Application is unrestricted to any particular trade channel, Applicant’s goods travel or will travel in the same channels of trade as Opposer’s goods, and are or will be purchased and used by the same types of consumers who purchase and use Opposer’s goods.

13. Opposer has not given Applicant permission or approval to use or register Applicant’s Mark.

14. Applicant’s Mark so resembles Opposer’s mark POST-IT as to be likely, when used on or in connection with the identified goods of Applicant, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the products Applicant intends to offer under Applicant’s Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its POST-IT brand of products. Opposer would be damaged by registration of Applicant’s Mark, which should be refused under 15 U.S.C. §§ 1052(d) and 1063.

15. Applicant's Mark is likely to cause dilution by blurring of Opposer's famous mark POST-IT, and registration should therefore be refused under 15 U.S.C. § 1125(c).

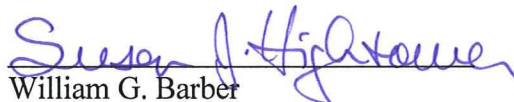
16. Registration of Applicant's Mark would be inconsistent with Opposer's rights in the mark POST-IT and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 77/726,137 be rejected, and that registration of Applicant's Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/3MTM:037/SJH, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: February 1, 2010



William G. Barber
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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail on February 1, 2010 on Applicant at the Correspondent address listed below:

Xerox Corporation
P.O. Box 4505
Norwalk, CT 06856-4505

A handwritten signature in blue ink, reading "Susan J. Highman", is written over a horizontal line.